

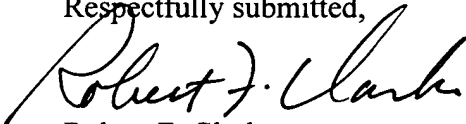
copper composite powder having the claimed structure." However, the Examiner does not explain how such a substitution could be accomplished. It is well-established that "[t]he prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success." MPEP §2143.02. In the same Office Action, the Examiner has stated that claims 18-22, which claim the method of making the Mo-Cu composite powder, are "free of the cited prior art." Since the cited prior art includes Dorfman et al. and Jech et al., the Applicants respectfully assert that there can be no reasonable expectation of success for making the claimed Mo-Cu composite powder from the cited references. In addition, the Applicants would also like to point out to the Examiner the holding of the CCPA in *In re Hoeksema* in which the court stated:

[I]t is our view that if the prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in the possession of the public... [T]he absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on close relationships between their structures and those of the prior art compounds. *In re Hoeksema*, 158 USPQ 596, 601 (CCPA 1968).

Therefore, since the Examiner has not shown how the claimed invention could be made from the cited prior art, the Applicants respectfully assert that the claimed invention is not obvious in view of Dorfman et al. and Jech et al.

In view of the foregoing amendment, it is believed that the Examiner's rejections have been overcome and that the application is in condition for allowance. Such action is earnestly solicited.

Respectfully submitted,



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